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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,349	03/15/2001	John Tree	SOA-336	3465
23353	7590	12/19/2003	EXAMINER	
RADER FISHMAN & GRAUER PLLC			KING, JUSTIN	
LION BUILDING			ART UNIT	
1233 20TH STREET N.W., SUITE 501			PAPER NUMBER	
WASHINGTON, DC 20036			2111	
DATE MAILED: 12/19/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,349

Applicant(s)

TREE ET AL.

Examiner

Justin I. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim 2 directs to the wireless connection, but neither the specification nor the claim limitations enable one to implement the wireless communication between the electronic device and the case.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said user" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim. Claims 2-8 are rejected because they incorporate claim 1's limitations.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Raubenheimer et al. (U.S. Patent No. 5,059,970) or Steiner et al. (U.S. Patent No. 5,528,248), or Hawkins et al. (U.S. Patent No. 6,442,637).

Referring to claim 1: Raubenheimer discloses a case (figure 1, structure 10) for an electronic device (figure 1, structure 22). Raubenheimer's case's exterior is the claimed first protective material that maintains the electronic device within the case. Raubenheimer's case includes a control interface (figure 1, structure 14), in electrical communication with the electronic device, and the user can operate an electronic feature of the electronic device. Thus, claim 1 is anticipated by the Raubenheimer.

Steiner discloses a case (figure 2, structure 30) for an electronic device (figure 2, structure 20). Steiner's case's exterior is the claimed first protective material that maintains the electronic device within the case. Steiner's case includes a control interface (figure 2, structure 38), in electrical communication with the electronic device, and the user can operate an electronic feature of the electronic device. Thus, claim 1 is anticipated by the Steiner.

Hawkins discloses a case (figure 3, structure 320) for an electronic device (figure 3, structure 300). Hawkin's case's exterior is the claimed first protective material that maintains

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the electronic device within the case. Hawkin's case includes a control interface (figure 3, the buttons of the structure 320), in electrical communication with the electronic device, and the user can operate an electronic feature of the electronic device. Thus, claim 1 is anticipated by the Hawkins.

Referring to claim 3: The prior arts disclose the connection port (Raubenheimer, figure 1, structure 20; Steiner, figure 2, structure 32; Hawkins, figure 3, structure 111).

Referring to claim 7: Raubenheimer's electronic device provides data and the controlling interface produces numerous command signals; thus, the controlling interface operates functions that are not operated by the command signals produced from the electronic interface. Both Steiner and Hawkins disclose a PDA, which has its own function other than the inserted electronic device; thus, both prior arts' controlling interfaces operate functions that are not operated by the command signals produced from the electronic interface.

7. Claims 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Raubenheimer or Steiner.

Referring to claim 8: The prior arts disclose the speaker (Raubenheimer, figure 1, structure 18; Steiner, figure 2, structure 34).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Steiner in view of the Bernard (U.S. Patent No. 5,497,339), or over the Hawkins in view of Bernard.

Referring to claims 4-5: Steiner discloses an Audio display (figure 2, structure 34), but Steiner does not explicitly specify it as an output jack. Hawkins does not explicitly disclose a audio output jack. Bernard discloses a communication device for the PDA, which includes a audio output jack (figure 2, structure 132). Hence, it would have been obvious to one having ordinary skill in the computer art at the time Applicant made the invention to adapt the Bernard's PDA expansion onto Steiner or Hawkins because Bernard teaches one to increase the functional capabilities of the PDA and turn the PDA into a portable multiple integrated communication device.

Referring to claim 6: Bernard discloses an electrical input (figure 3, structure 70) through which power is provided to store a charge for the PDA. Although Bernard does not explicitly disclose that the PDA itself provides a charge to its connected electronic device, Bernard teaches that it is known to provide the charge to the connected electronic device (in Bernard's case, the connected electronic device is the PDA).

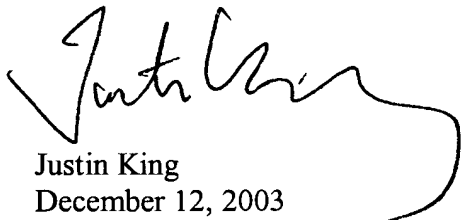
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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin King whose telephone number is (703) 305-4571. The examiner can normally be reached on Monday through Friday from 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephones are unsuccessfully, the examiner's supervisor, Mark Reinhart can be reached at (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703)-306-5631.


Justin King
December 12, 2003


XUAN M. THAI
PRIMARY EXAMINER
TC2100